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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,176	02/03/2000	Pierre Ardaud	022701-863	7179

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/497,176

Applicant(s)
Ardaud et al.

Examiner
Rabon Sergeant

Art Unit
1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Claims 15, 16, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 15 and 41, it is unclear if the "wherein at least one of the isocyanates" language refers to all of the isocyanates encompassed by the "one or more additional isocyanates" language within lines one and two of the claims. In other words, it is unclear if the claims provide for the presence of masked isocyanates which lack the polymethylene chains. Furthermore, it is unclear how to interpret the "one third or more" language. Does the language refer to one-third of the structure of each masked isocyanate or to one-third of the number of the masked isocyanates? Lastly, it is unclear if the "one third or more" language is on a weight or molar basis.

2. Claims 1-24 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1 and 51, it is unclear if the percent value for the degree of liberation is a mole or weight percent. Furthermore, the basis of the percent is unclear.

3. Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for high gloss yielding compositions which contain the features disclosed within lines 2-26 of page 4 of the specification, does not reasonably provide enablement for coating compositions intended to yield high gloss finishes which lack one or more of the

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aforementioned features. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The examiner has considered applicants' response and disclosure, and the position is maintained that applicants have failed to provide adequate enablement for the production of viable high gloss yielding compositions when the composition is not governed by all of the features disclosed within page 4. For example, claim 25 lacks language pertaining to the degree of liberation with respect to the masking agent and claim 1 lacks language pertaining to the glass transition temperature of the isocyanate and the conditions specified at lines 15-26 of page 4. It is not agreed that the features disclosed at page 4, lines 9-26 constitute preferred embodiments. In the absence of the aforementioned features, one of ordinary skill would have to resort to undue experimentation in order to obtain high gloss coatings, as opposed to matte or satin coatings. This position is logical in view of the similarities between the teachings of Ardaud et al. ('624) and the instant claims. It is noted that Ardaud et al. are drawn to the production of matte or satin coatings. Additionally, applicants' argument fails to provide reasoning as to why the degree of liberation characteristic is not a necessary limitation for claim 25.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
January 12, 2003


RABON SERGENT
PRIMARY EXAMINER